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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,694	08/05/2003	Jeffrey A. Anderson	14917.0002	7611
27890 7590 10/07/2009 STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				
EXAMINER				
CHAPMAN, JEANETTE E				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
10/07/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/633,694

Applicant(s)

ANDERSON, JEFFREY A.

Examiner

Jeanette E. Chapman

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-15, 27-30, 32-34, 36-44, 49-51, 53-58, 60 and 61 is/are pending in the application.
- 4a) Of the above claim(s) 27-30, 32-34, 36-43, 49-51, 53 and 56-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-15, 44, 54, 55, 60 and 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 61 has not clear meaning and is perhaps indefinite with the use of the following language, "..... a plurality of reinforcements exclusively in the web elements and two flanges, each flange extending from the web region, and from two, three or five columns of web slots extending along a portion of the length in the web region or at least one of the flanges; wherein the formed metal sheet further includes a closing region extending between the flanges to form a substantially tubular structure." Further, where does this language find support in the specification?

The amendment filed 11/9/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater".

Applicant is required to cancel the new matter in the reply to this Office Action. Claims 1,3-15, 44, 54-55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-5,9,11-14, 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sucato (5605024).
claim 1.

Sucato et al discloses a metal framing member comprising: a formed metal sheet having a length and including a web region 64 including a plurality of expanded web slots 65 including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements 66 proximate to the web slots and confined to the web elements and exclusive to the web voids, and each expanded web slot has a length to width ratio of about 2:1 or greater as shown in figure, and sucato lacks the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Applicant has not shown the criticality and relevancy for including these ratios. Applicant has not shown that ratios outside the recited ratios cause the framing member to not function as intended or to function unfavorably. One of ordinary skill in the art would have appreciated providing the proper ration of web slots to voids which would provide the

intended framing member with the intended function

2. (Canceled)

claim 3.

Sucato discloses the member of claim 1, wherein the formed metal sheet includes a web region 64 and a first flange 62 extending from the web region 64. claim 4.

Sucato et al discloses the member of claim 3, wherein the formed metal sheet further includes a second flange 63 extending from the web region 64 in a direction substantially parallel to the first flange 62.

claim 5.

Sucato et al discloses the member of claim 3, wherein the web region 64 includes the expanded web slots. See figures 20-21. claim 9.

Sucato discloses the member of claim 4, wherein the formed metal sheet further includes a closing region extending the first flange to the second flange to form a substantially tubular structure. See annotations below.

Claim 11.

Sucato discloses that the member of claim 1, wherein each web slot extends along a portion of a length of the member.

Claim 12.

Sucato discloses the member of claim 1, wherein the plurality of web slots is arranged in offset columns substantially parallel to a length of the member. See figures 20-21.

Claim13.

Sucato discloses the member of claim 1, wherein the plurality of web slots form three or more columns of slots along the length of the member. See figures 20-21

Claim 14.

Sucato discloses the member of claim 13, wherein the plurality of web slots form five or more columns of slots along the length of the member. See figures 20-21.

Claim 54.

A metal framing member comprising: a formed metal sheet including a plurality of expanded web slots in a region of the formed metal sheet; sucato does not disclose the expanded web slots are heat treated; but discloses each expanded web slot having a length to width ratio of 2:1 or greater. Sucato lacks the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Applicant has not shown the criticality and relevancy for including these ratios. Applicant has not shown that ratios outside the recited ratios cause the framing member to not function as intended or to function unfavorably. One of ordinary skill in the art would have appreciated providing the proper ration of web slots to voids which would provide the intended framing member with the intended function.

Heat treatment is a common process that has been around for many years to strengthen the mechanical metal structure after forming claim 55. Further the structure is not limitd to a heat treatment process to form the same; the structure is not limited to the process since the same is shown without the process. Applicant is not claiming a process but a product

Sucato discloses 66 The member of claim 1, wherein the reinforcements include a dart

or dimple 66.

Claims 6-8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sucato et al (5605024) in view of Ekerholm (6205740) claim 6.

Sucato lacks the member of claim 3, wherein the first flange includes the expanded web slots. Ekerholm discloses a framing member with flanges having expandable regions 2 and 3. It would have been obvious to one of ordinary skill in the art to modify Sucato et al to include the framing member with flanges having expanded web slots to provide more adjustment characteristics to the frame as needed claim 7.

With the modification of Ekerholm to Sucato, the member of claim 3, each of the web region and the first flange includes the expanded web slots.

Claim 8.

With the modification of Ekerholm to Sucato et al, the member of claim 5, each of the web region, the first flange and the second flange includes the expanded web slots.
claim 10.

Sucato discloses the web region includes the expanded web slot and the closing region including the expanded web slots. Ekerholm et al discloses the first flange and the second flange and the closing region includes the expanded web slots. See obviousness rational above for including the ekerholm reference.

Claims 15, 44, 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sucato et al (5605024) in view of Bodnar (5527625)

Claim 15.

Bodnar discloses a framing member with voids and reinforcements 100, 102, 104 and additional reinforcements 94/96/98

It would have been obvious to include these reinforcement or flanges to strengthen the from material around the opening or slits.

Claim 44.

Bodnar discloses the reinforcements include a strengthening flange. See obviousness rational above for combining Bodnar with Sucato.

Claim 60.

Sucato discloses a metal framing member comprising: a formed metal sheet having a web region 64 including a plurality of expanded web slots adjacent 65 provided in columns extending in the web region of the formed sheet metal and two flanges extending from the web region 64, wherein the web region includes web elements 65 but lacks and a plurality of reinforcements exclusively in the web elements as shown by Bodnare, see above; wherein the formed metal sheet

Sucato includes a closing region as shown in the embodiment of figure 2 and 19 with elements 26 and 27 extending the first flange 62 to the second flange 63 to form a substantially tubular structure as shown in figures 2 and 19, and wherein the formed metal sheet further includes a second flange 62 extending from the web region in a direction substantially parallel to the first flange 62. See obviousness rational above for combining Sucato to Bodnar

claim 61.

Sucato discloses a metal framing member prior to expansion comprising: a formed

metal sheet having a length and including a web region 64 including web elements 65 but lacks a plurality of reinforcements exclusively in the web elements and Sucato discloses two flanges 62 and 63, each flange extending from the web region 64, and from two slots extending along a portion of the length in the web region; wherein the formed metal sheet further includes a closing region 26/27 extending between the flanges to form a substantially tubular structure. See figure 2 and 19 and the accompanying text

Applicant's arguments have been considered but are not deemed persuasive.

Applicant argues, "MPEP 2163.02 states that "[t]he subject matter of the claim need not be described literally in order for the disclosure to satisfy the description requirement. (emphasis added)." The subject matter needs to be described such that the ratios are disclosed. The ratios do not correspond with the percentages disclosed in the specification.

applicant also argues, "Sucato does not teach or suggest a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length and including a web region including a plurality of

expanded web slots including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot has a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater. Sucato also does not teach or suggest a metal framing member including a formed metal sheet including a plurality of expanded web slots in a region of the formed metal sheet, wherein the expanded web slots are heat treated, each expanded web slot having a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater."

Sucato does teach a metal framing member comprising: a formed metal sheet having a length and including a web region 64 including a plurality of expanded web slots 65 including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements 66 proximate to the web slots and confined to the web elements and exclusive to the web voids. Sucato does teach or suggest a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length. Bodnar discloses the reinforcements and there is no support in the specification for the ratios. See new

matter rejection above. The web slots being heat treated is a matter of choice not critical to forming the structure nor shown to be critical to forming the structure. Applicant is not claiming a process but a product; the product by process limitation is not critical or relevant since the product is shown and hence the process need not be shown

Applicant further states, ".....The Anderson Declaration states that "[t]he combination of a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot having a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater are necessary to achieve the structure on the web that is not available when these features are not all present in combination." See paragraph 4 of the Anderson Declaration. Thus, Applicant has demonstrated the criticality and relevancy of these ratios with respect to the formed metal sheet.. As stated above, the ratios are considered new matter. Further as much as applicant believes the claimed ratios are equivalent to the disclosed percentages without support in the original specification, so are applicants shown values or percentages equal to the claimed dimensions whether ratios or percentages; the values lack criticality and relevancy because the ratios are not supported in the specification. If applicant did not feel it was necessary to mention these ratios in the specification, how can the values be considered relevant and significant having criticality.

Applicant also argues, "Such a defect is not remedied by Ekerholm either. Ekerholm describes "[a]n elongate supporting element [that] has a cross section with a web (9) and two side flanges (10, 11) for the supporting of building panels or the like." See Abstract. Ekerholm does not teach or suggest a metal framing member including a formed metal sheet having a length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length and including a web region including a plurality of expanded web slots including voids and metal web elements and extending along a portion of the length, wherein the region includes a plurality of reinforcements proximate to the web slots and confined to the web elements and exclusive to the web voids, each expanded web slot has a length to width ratio of 2:1 or greater, and the ratio of the distance between adjacent slots prior to expansion to a width of the formed metal sheet prior to expansion is 1:8 or greater.' But Eckholm was not cited to show the above but to show the framing member with flanges having expanded regions

Regarding the Declaration of Roger A. Laboube:

The declaration does not shows the equivalence of the 1:8 ratio and the specification page 6, line 26. Meaning the information in the declaration does not overcome the new matter rejection nor does it overcome or influence in any way the prior art rejection. Further, there is no nexus between what is disclosed in the declaration and what is recited in the claims.

Regarding the Declaration of Francis J. Roost:

The declaration does not shows the equivalence of the 1:8 ratio and the specification

page 6, line 26. Meaning the information in the declaration does not overcome the new matter rejection nor does it overcome or influence in any way the prior art rejection. Further, there is no nexus between what is disclosed in the declaration and what is recited in the claims

Regarding exhibits B (Market (2002) in Tons After Applying Factors), C (Derivation of Weight per Foot (interior wall)), D (AMM Steel Base prices), E(derivation of material Savings) and the Data of Non-Statistical Analysis of the use of Cold Formed Steel in no Residential Construction. The above documents contains an excessive amount of information and data and some directed to commercial success. The claims of commercial success lacks a direct link and relevance to the claims. Further there is no evidence in the document overcoming the prior art or the new matter rejection. Further applicant does not reference or underline any information within the documents that directly relate to the claim language or provide information in overcoming the new matter rejection.

Regarding the Declaration of Jeffery Anderson:

The above declaration does not provide proof that the ratios in the claims correspond to the percentages in the written specification; This declaration merely speaks of the percentages.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeanette Chapman/
Primary Examiner, Art Unit 3633